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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,219	08/29/2001	Yuji Suzuki	81800.0166	8883

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EXAMINER

MENBERU, BENIYAM

ART UNIT PAPER NUMBER

2626

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/943,219	<b>Applicant(s)</b> SUZUKI ET AL.	
	<b>Examiner</b> Beniyam Menberu	<b>Art Unit</b> 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 August 2001.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☒ Claim(s) 3 and 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/2/04, 8/29/01</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

1. The abstract of the disclosure is objected to because.  
  
The abstract contains more than 150 words.  
  
The abstract contains more than one paragraph.  
  
Correction is required. See MPEP § 608.01(b).
2. The disclosure is objected to because of the following informalities:  
  
On page 10, lines 22, "S 21" should be "S21".  
  
On page 12, line 17, "generates" should be "generate".  
  
On page 13, lines 3, "S 41" should be "S41".  
  
On page 17, line 17, "step 9" should be "step s9".  
  
On page 20, line 22, "line L is no" should be "line L is not".  
  
Appropriate correction is required.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/927178. Although the conflicting claims are not identical, they are not patentably distinct from each other because both of the claims disclose a communication terminal comprising of a network control unit for closing and opening a circuit, recording unit, and a control unit that does not accept incoming calls by closing the circuit using the network control unit in the case of a recording unit failure. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Claim Objections***

5. Claim 3 is objected to because of the following informalities: On line 3 of claim 3, "operate" should be "operated". Appropriate correction is required.

6. Claim 7 is objected to because of the following informalities: On line 7 of claim 7, "from the" should be "on the". Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 2, 3, 5, 6, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5675421 to Ouchi in view of U.S. Patent No. 4638368 to Shimizu et al.

Regarding claim 1, Ouchi discloses a communication terminal comprising:  
a network control unit for closing and releasing the circuit (column 3, lines 15, lines 22-24);  
an operating key for making the network control unit release the circuit (column 3, lines 28-33);  
a recording unit for recording the image data in the recording medium (column 3, lines 37-40);  
a control unit which refuses an incoming call by maintaining the state of closing the circuit with the network control unit (column 11, lines 21-26). However Ouchi does not disclose a control unit that invalidates the operation and input of the said operating key in the case the recording unit fails to operate.

Shimizu et al disclose a communication apparatus that invalidates the operation and input of the said operating key in the case the recording unit fails to operate (column 6, lines 33-42).

Ouchi and Shimizu et al are combinable because they are in the similar problem area of facsimile transmission.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the operating key invalidation taught by Shimizu et al with the

communication terminal of Ouchi to implement communication terminal with operating key invalidation during failure.

The motivation to combine the reference is clear because during recording failure it would be advantageous to prevent user from interfering with the operation of the facsimile machine so that the facsimile machine can recover from the failure (Shimizu et al: column 6, lines 33-37).

Regarding claim 2, Ouchi in view of Shimizu et al teach all the limitations of claim 1. Shimizu et al disclose a communication terminal according to claim 1 comprising: an informing means for informing the fact that the operation of the said operating key is invalid (column 4, lines 54-61).

Regarding claim 3, Ouchi in view of Shimizu et al teach all the limitations of claim 2. Shimizu et al disclose a communication terminal according to claim 2 characterized in that the fact that the operation is invalid is informed when the operating key is operated.

Regarding claim 5, Ouchi in view of Shimizu et al teach all the limitations of claim 3. Further Shimizu et al disclose a communication terminal according to claim 3 characterized in that the informing means is a buzzer (column 6, lines 15-20).

Regarding claim 6, Ouchi in view of Shimizu et al teach all the limitations of claim 3. Further Shimizu et al disclose A communication terminal according to claim 3 characterized in that the informing means is the display (column 4, lines 37-40).

Regarding claim 14, Ouchi in view of Shimizu et al teach all the limitations of claim 1. Further Ouchi disclose a communication terminal according to claim 1

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characterized in that the control unit maintains the state of closing the circuit with the network control unit when the recording unit fails to operate and a image memory is overflowed, comprising: said image memory (column 11, lines 21-27).

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5675421 to Ouchi in view of U.S. Patent No. 4638368 to Shimizu et al further in view of U.S. Patent No. 6252672 to Sugawara et al.

Regarding claim 4, Ouchi in view of Shimizu et al teach all the limitations of claim 1. However Ouchi in view of Shimizu et al does not disclose a communication terminal according to claim 1 characterized in that the control unit makes the network control unit close the circuit according to the setting of the setting means in the case the recording unit fails to operate comprising: a setting means for setting whether or not the circuit is to be closed when the recording unit fails to operate.

Sugawara et al disclose a communication terminal according to claim 1 characterized in that the control unit (Figure 1, CPU 1) makes the network control unit (Figure 1, NCU 4) close the circuit according to the setting of the setting means in the case the recording unit fails to operate comprising: a setting means for setting whether or not the circuit is to be closed when the recording unit fails to operate (column 7, lines 45-61).

Ouchi, Shimizu et al, and Sugawara et al are combinable because they are in the similar problem area of facsimile transmission.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the setting means of Sugawara et al with the facsimile system

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of Ouchi in view of Shimizu et al to implement a system that is capable of handling failure.

The motivation to combine the reference is clear because if the recording fails there is a need to terminate the line to prevent erroneous reception.

10. Claims 7, 8, 9, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5675421 to Ouchi in view of U.S. Patent No. 6434343 to Kobayashi et al.

Regarding claims 7 and 8, Ouchi discloses a communication terminal comprising:

a network control unit for closing and releasing the circuit (column 3, lines 15, lines 22-24);

a recording unit for recording the image data in the recording medium (column 3, lines 37-40); and

a control unit which refuses an incoming call by maintaining the state of closing the circuit with the network control unit (column 11, lines 21-26). However Ouchi does not disclose an informing unit or a display unit for informing or displaying the functions capable of being used on the informing/display unit, in the case the recording unit fails to operate.

Kobayashi et al disclose an informing unit/display unit (column 10, lines 26-31) for informing or displaying the functions capable of being used on the informing/display unit in the case the recording unit fails to operate (column 11, lines 31-40).



Ouchi and Kobayashi et al are combinable because they are in the similar problem area of facsimile transmission.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine display unit with the facsimile system of Ouchi to implement a communication terminal that is capable of informing user of the status of the terminal.

The motivation to combine the reference is clear because a user needs to know the status of the communication terminal before use (column 10, lines 28-31).

Regarding claim 9, Ouchi in view of Kobayashi et al teach all the limitations of claim 8. Further Kobayashi et al disclose a communication terminal according to claim 8 characterized in that the message which indicates that the facsimile transmission or the telephone is capable of being carried out, is displayed (column 13, lines 30-32).

Regarding claim 15, Ouchi in view of Kobayashi et al teach all the limitations of claim 7. Further Ouchi disclose a communication terminal according to claim 7 characterized in that the control unit maintains the state of closing the circuit with the network control unit when the recording unit fails to operate and a image memory is overflowed, comprising said image memory (column 11, lines 21-27).

Regarding claim 16, Ouchi in view of Kobayashi et al teach all the limitations of claim 8. Further Ouchi discloses a communication terminal according to claim 8 characterized in that the control unit maintains the state of closing the circuit with the network control unit when the recording unit fails to operate and a image memory is overflowed, comprising: said image memory (column 11, lines 21-27).

11. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5675421 to Ouchi in view of U.S. Patent No. 6434343 to Kobayashi et al further in view of U.S. Patent No. 6701095 to Fujimoto et al.

Regarding claim 12, Ouchi in view of Kobayashi et al teach all the limitations of claim 7. However Ouchi in view of Kobayashi et al does not disclose a communication terminal according to claim 7 characterized in that the functions capable of being used is informed in a voice message.

Fujimoto et al disclose a communication terminal characterized in that the functions capable of being used is informed in a voice message (column 31, lines 53-67).

Ouchi, Kobayashi et al, and Fujimoto et al are combinable because they are in the similar problem area of facsimile transmission.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the voice message informing unit of Fujimoto et al with the system of Ouchi in view of Kobayashi et al to implement a voice based facsimile system.

The motivation to combine the reference is clear because voice message provides an alternative to informing users of the status of a facsimile machine.

12. Claims 10, 11, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5675421 to Ouchi in view of U.S. Patent No. 6414759 to Ikegami et al.

Regarding claim 10, Ouchi disclose a communication terminal comprising:  
a network control unit for closing and releasing the circuit (column 3, lines 15, lines 22-24);  
a speaker (column 3, lines 15-16);  
a recording unit for recording the image data in the recording medium (column 3, lines 37-40); and  
a control unit which refuses an incoming call by maintaining the state of closing the circuit with the network control unit (column 11, lines 21-26). However Ouchi does not disclose a control unit which outputs the melody which indicates the closing of the circuit, from the speaker, in the case the recording unit fails to operate.

Ikegami et al disclose a control unit (column 2, lines 61-62) which outputs the melody which indicates the closing of the circuit, from the speaker, in the case the recording unit fails to operate (column 3, lines 41-46).

Ouchi and Ikegami et al are combinable because they are in the similar problem area of facsimile transmission.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the melody unit of Ikegami et al with the facsimile system of Ouchi to implement a practical facsimile system.

The motivation to combine the reference is clear because a user can readily know that a communication line is closing with the use of a melody.

Regarding claim 11, Ouchi in view of Ikegami et al teach all the limitations of claim 10. Further Ikegami et al disclose a communication terminal according to claim 10

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characterized in that the control unit outputs from the speaker the said melody based on the setting of the setting means, further comprising: a setting means for setting whether or not the melody which indicates the closing of the circuit, to be output (column 3, lines 41-46. Since Ikegami et al disclose that the user has option to be notified of a disconnection either by display, alarm sound or voice, Ikegami et al implies an option for setting the method of notification. ).

Regarding claim 17, Ouchi in view of Ikegami et al teach all the limitations of claim 10. Further Ouchi disclose a communication terminal according to claim 10 characterized in that the control unit maintains the state of closing the circuit with the network control unit when the recording unit fails to operate and a image memory is overflowed, comprising: said image memory (column 11, lines 21-27).

13. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5675421 to Ouchi in view of U.S. Patent No. 6414759 to Ikegami et al further in view of U.S. Patent No. 6728534 to Izumi et al.

Regarding claim 13, Ouchi in view of Ikegami et al teach all the limitations of claim 11. However Ouchi in view of Ikegami et al does not disclose a communication terminal according to claim 11 characterized in that the circuit closing melody of which is different from the melody of the holding melody output when holding a telephone conversation, is output from the speaker.

Izumi et al disclose holding melody generator (Figure 2, reference 216) that generates melody during holding (column 9, lines 14-24). In combination with the

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system of Ikegami et al, the closing melody as set in Ikegami et al (for example using a voice) can be set differently than the holding melody as set by Izumi et al.

Ouchi, Ikegami et al, and Izumi et al are combinable because they are in the similar problem area of facsimile transmission.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the holding melody generation of Izumi et al with the system of Ouchi in view of Ikegami et al further in view of Izumi et al to implement facsimile with audio output capability during failure.

The motivation to combine the reference is clear because different melodies are necessary to inform user of different events.

14. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5675421 to Ouchi in view of U.S. Patent No. 4638368 to Shimizu et al further in view of U.S. Patent No. 5956155 to Nakamura et al.

Regarding claim 18, Ouchi in view of Shimizu et al teach all the limitations of claim 1. However Ouchi in view of Shimizu et al does not disclose a communication terminal according to claim 1 characterized in that the operating key for releasing the circuit is a hook key.

Nakamura et al disclose a communication terminal according to claim 1 characterized in that the operating key for releasing the circuit is a hook key (column 4, lines 15-22).

Ouchi, Shimizu et al, and Nakamura et al are combinable because they are in the similar problem area of facsimile transmission.

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At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine hook key used in releasing the circuit as taught by Nakamura et al with the facsimile system of Ouchi in view of Shimizu et al to implement a facsimile system of with a hook key.

The motivation to combine the reference is clear because a hook key provides for practical method for disconnecting and connecting a communication line.

#### ***Other Prior Art Cited***

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6198948 to Sudo et al disclose a telephone apparatus

U.S. Patent No. 6427004 to Minamizawa et al disclose communication apparatus with sound output.

U.S. Patent Application Publication No. US 2002/0057773 A1 to Fujise et al disclose communication apparatus with incoming call judging unit.

U.S. Patent Application Publication No. US 2005/0024676 A1 to Yamagishi disclose computer with multiple printer connection.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beniyam Menberu whose telephone number is (703) 306-3441. The examiner can normally be reached on 8:00AM-4:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is (703) 306-5631. The group receptionist number for TC 2600 is (703) 305-4700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

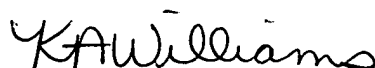
For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Patent Examiner**

Beniyam Menberu

BM

02/18/2005



KIMBERLY WILLIAMS  
SUPERVISORY PATENT EXAMINER